



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,571	07/21/2003	Masaru Iriya	0071-0528P	4799

2292 7590 03/01/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

RAYFORD, SANDRA M

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,571

Applicant(s)

IRIYA ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-2-04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims

1. Pursuant to the amendment in the response dated 02 December 2004 ("the last response"), claims 1-13 are pending.

Claims 8-13 are new.

There are no cancelled claims.

Notes:

a. Claim 6 is an improper multiple dependent claim. The examiner has treated it as if it were dependent upon claim 1.

b. Claim 2 is improper for reciting "A wrap film roll." Claim 1, from which it depends, is directed to a wrap film.

c. Claims 6 and 7 improperly recite "A wrap product." Claim 1, from which they depend, covers a wrap film.

2. The examiner requests that applicants voluntarily revise claims 2, 6 and 7 in view of the notes immediately above.

Summary of Base Claim

3. Claim 1 covers a wrap film comprising at least one surface layer of a composition C, which composition comprises:

-100 parts by mass of an aliphatic polyester

-5 to 40 parts by mass of a liquid additive B,

wherein the film has a surface roughness of 0.5 to 4.0 nm, a tensile modulus of 400 to 1500 Mpa, is heat resistant to temperatures of 130°C or more, and has cling energy of 0.5 to 2.5 mJ.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 02 December 2004 was considered by the examiner.

Priority

5. Pursuant to applicants' request on page 15 of the 02 December 2004 response, the examiner notes that:

A certified copy of applicants' Japanese priority document was received on 21 July 2003.

An English translation of SN. 60/447243 was received on 09 October 2003.

Double Patenting

6. This examiner has found no basis for a double patenting rejection over the original claims of SN. 10/496141. Those claims do not cover articles that include an aliphatic polyester in a surface layer.

Rejections Withdrawn

7. The 35 USC 112 rejection of claim 3, recited in section 4 of the 03 September 2004 office action ("the last office action"), is withdrawn in view of the amendment to that claim in the last response.
8. The 35 USC 103 rejection of claims 1 and 3-5 as unpatentable over Topolkaraev et al (US 6,660,211) in view of Shibata et al (PG pubn. 2002/0102423A1) is withdrawn in order to apply the new ground of rejection set out below.

Art Unit: 1772

9. The 35 USC 103 rejection of claims 1-5 as unpatentable over Shibata et al in view of Kuroki et al (EP 1029890A2) is withdrawn in order to apply the new ground of rejection set out below.

Rejection Maintained

10. The 35 USC 103 rejection of claims 6-7 as unpatentable over Shibata and Kuroki with the JP 05-162747 (abstract) is maintained for reasons of record.

New Rejections

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 3-5 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Topolkaraev in view of Shibata.

The combination of Topolkaraev and Shibata is discussed in section 7 of the last office action. Claims 1, 3-5 and 8-13 are rejected for the reasons stated there.

Art Unit: 1772

The process limitations of the new claims do not distinguish the claimed articles from those suggested by the combination of references.

14. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Kuroki et al.

The combination of Shibata and Kuroki is discussed in section 8 of the last office action. Claims 1-13 are rejected for the reasons stated there.

The process limitations of the new claims do not distinguish the claimed articles from those suggested by the combination of references.

Response to Arguments

15. Applicant's arguments filed in the last response have been fully considered but they are not persuasive.

On pages 9-10 of the response, applicants argue that the surface roughness of the Shibata films is not that recited in their claims.

However, applicants have not presented convincing objective evidence that the claimed surface roughness or that the properties of "wrap films", particularly "food wrapping films", having them, are unexpected in view of the combined references' teachings.

On pages 10-11 and 14-15, applicants argue that the process by which they make their films is a key feature of the invention.

However, the claims at issue are article claims. The process limitations that applicants argue have no bearing on the patentability of the article claims, in the

absence of convincing objective evidence that the process is the only one that can make films having the properties recited in the claims.

On page 12, applicants argue that one would not be motivated to modify the surface roughness of the Topolkaraev films.

However, the surface roughness of films used in diapers and training pants (as recited at col. 1, line 18 of Topolkaraev) is a property that would affect consumer acceptance of such articles. It is presumed that people wearing diapers prefer to be comfortable and that rough-surfaced diapers are not comfortable.

On page 14, applicants assert that Kuroki "only hints that their polyester resin [is useful] in . . . food wrapping film".

However, Kuroki's "hint" is a suggestion, and, arguably, a teaching.

Final Rejection

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 1772

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.


S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

10622571(20050226)